



IN THE
UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant(s): Jon A. Brewster et al
Application No.: 09/325040

Confirmation No.: 2318

Filing Date: Jun 07, 1999

Examiner: Myhre, James W.

Title: Document Delivery System For Automatically Printing A Document On A Printing Device

Mail Stop Appeal Brief-Patents
Commissioner For Patents
PO Box 1450
Alexandria, VA 22313-1450

TRANSMITTAL OF APPEAL BRIEF

Sir:

Transmitted herewith in **triplicate** is the Appeal Brief in this application with respect to the Notice of Appeal filed on 04/16/2004.

The fee for filing this Appeal Brief is (37 CFR 1.17(c)) \$330.00.

(complete (a) or (b) as applicable)

The proceedings herein are for a patent application and the provisions of 37 CFR 1.136(a) apply.

(X) (a) Applicant petitions for an extension of time under 37 CFR 1.136 (fees: 37 CFR 1.17(a)-(d) for the total number of months checked below:

| | |
|------------------|-----------|
| (X) one month | \$110.00 |
| () two months | \$420.00 |
| () three months | \$950.00 |
| () four months | \$1480.00 |

() The extension fee has already been filled in this application.

() (b) Applicant believes that no extension of time is required. However, this conditional petition is being made to provide for the possibility that applicant has inadvertently overlooked the need for a petition and fee for extension of time.

Please charge to Deposit Account **08-2025** the sum of **\$440.00**. At any time during the pendency of this application, please charge any fees required or credit any over payment to Deposit Account 08-2025 pursuant to 37 CFR 1.25. Additionally please charge any fees to Deposit Account 08-2025 under 37 CFR 1.16 through 1.21 inclusive, and any other sections in Title 37 of the Code of Federal Regulations that may regulate fees. A duplicate copy of this sheet is enclosed.

(X) I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to:
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Respectfully submitted,

Jon A. Brewster et al

By

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Reg. No. 32,057

Date: June 21, 2004

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

5

In re application of: Jon A. Brewster et al

Art Unit: 3622

Examiner: J. Myhre

Serial Number: 09/325,040

Filed: June 7, 1999

10 Title: Document Delivery System for Automatically Printing a
Document on a Printing Device

Date: June 21, 2004

APPEAL BRIEF UNDER 37 CFR §1.192

15

TO THE ASSISTANT COMMISSIONER FOR PATENTS:

Sir:

20 This Brief is submitted in triplicate in support of the Appeal in the above-
identified application.

1. REAL PARTY IN INTEREST

25 The real party in interest is the Hewlett-Packard Company.

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2. RELATED APPEALS AND INTERFERENCES

Appellants, Appellants' legal representative, and Assignee are unaware of
5 any other appeals or interferences which would directly affect or be directly
affected by or have a bearing on the Board's decision in the pending appeal.

3. STATUS OF THE CLAIMS

10 Claims 1-22, 33-48, and 77-85 stand finally rejected by the Examiner as
noted in the Advisory Action dated January 16, 2004.

4. STATUS OF AMENDMENTS

15 No amendments have been filed subsequent to the final rejection.

5. SUMMARY OF INVENTION

Applicants invented a document delivery method and system that
20 automatically prints a document to a printing device¹ at a user requested time,
without user intervention². Other aspects of the invention include indicating that
the document printed successfully³, and subsidizing the purchase of a product,
such as a product consumed during the printing operation (e.g., print
consumable, media, ink, etc), based on monitoring the usage of the printing
25 device⁴.

¹ See Fig 1, Reference numerals 10, 320, 10320.

² See Fig 7 and Page 8 line 27 to Page 9 line 7.

³ See Fig. 3.

⁴ See Page 10 lines 4-16.

6. ISSUES

- Did the Examiner properly establish a case of *prima facie* obviousness, as required by the Manual of Patent Examining Procedure⁵, *In re Lintner*⁶, and *In re Reuter*⁷, *et al*, in rejecting:
 - claims 1-3, 12-15, 33, and 77-80 over Griebenow⁸ in view of Austin⁹?
 - claims 34-38 and 43-48 over Logan¹⁰?
 - claims 4-11, 16-22, 39-42, and 81-85 over Griebenow in view of Austin in further view of Logan?

10

7. GROUPING OF THE CLAIMS

Appellants expressly state that the rejected claims do not rise or fall together as a single group. Appellants consider the groups of claims in the following table to be separately patentable. The additional columns in this table indicate summarized versions of specific novel and non-obvious aspects of Appellants' invention, as claimed, that will be discussed in more detail in the Argument section of this appeal brief:

⁵ Manual of Patent Examining Procedure, §2142.

⁶ *In re Lintner*, 458 F.2d 1013, 173 USPQ 560 (CCPA 1972).

⁷ *In re Reuter*, 651 F.2d 751, 210 USPQ 249 (CCPA 1981).

⁸ Griebenow et al, US patent 5,850,520.

⁹ Austin, US patent 6,157,924.

¹⁰ Logan et al, US patent 5,721,827.

| Group | Claims in Group | Print at user-specified time | Subsidize product based on monitored usage of printing device | Update user profile with Indication document printed successfully | Subsidize product depleted by printing operation | Update user profile with amount of ink used by printing operation | Update user profile with amount of different colored ink used by printing operation |
|--------------|------------------------|-------------------------------------|--|--|---|--|--|
| I | 1, 2, 12, 13, 14 | X | | | | | |
| II | 34, 42-48 | | X | | | | |
| III | 77 | | | X | | | |
| IV | 3, 15, 33, 78-80 | X | | X | | | |
| V | 39, 40, 41, 81, 82-85 | | X | | X | | |
| VI | 4, 16 | X | X | X | | | |
| VII | 5-11, 17-22 | X | X | X | X | | |
| VIII | 35, 36 | | X | X | | | |
| IX | 37 | | X | | | X | |
| X | 38 | | X | | | | X |

8. ARGUMENT

5

8A. Overview

Griebenow discloses a method and system for distributing an electronic document to a personal computer via email. The document can contain 10 customized advertising and/or content. A return receipt is sent to the deliverer of the electronic publication when the electronic publication is delivered to the user. While Griebenow discloses that the personal computer is attached to a variety of input/output devices, including a printer, Griebenow fails to disclose that the

electronic document is intended to be printed, and in fact teaches away from this view by consistently referring to the document as an "electronic document", and stating that the electronic document is "used" for various periods of time.¹¹

5 Austin discloses systems, methods, and computer program products for delivering information, such as financial statements, over a preferred medium. Austin discloses that one of the preferred media could be a printer, but Austin fails to disclose how the document could be printed at a user-specified time.

10 Logan discloses a system for electronically distributing personalized broadcasted audio or video information. While Logan mentions that text files can also be sent, Logan fails to disclose that these text files are printed.

15 **8B. Did the Examiner properly establish a case of *prima facie* obviousness, as required by *In re Reuter*, in rejecting claims 1-22, 33-48, and 77-85 under 35 USC § 103(a) over Griebenow, Austin, and/or Logan?**

20 The Manual of Patent Examination Procedure provides instructions to the examiners on how to properly establish a case of *prima facie* obviousness:

25 To reach a proper determination under 35 U.S.C. 103, the examiner must step backward in time and into the shoes worn by the hypothetical "person of ordinary skill in the art" when the invention was unknown and just before it was made. In view of all factual information, the examiner must then make a determination whether the claimed invention "as a whole" would have been obvious at that time to that person. Knowledge of applicant's disclosure must be put aside in reaching this determination, yet kept in mind in order to determine the "differences," conduct the search and evaluate the "subject matter as a whole" of the invention. The tendency to resort to "hindsight" based upon applicant's disclosure is often difficult to avoid due to the very nature of the examination process. However, impermissible hindsight must 30 be avoided and the legal conclusion must be reached on the basis of the facts gleaned from the prior art.¹²

¹¹ Griebenow, Col 10, lines 31-47.

¹² Manual of Patent Examining Procedure, §2142.

8B-I: The Examiner failed to establish a prima facie case of obviousness that Griebenow and Austin, taken singly or together, disclose, teach or suggest Appellants' Group I claims

5

Claim 1 is representative of the Group I claims. Claim 1 claims the following:

10 1. In a document delivery system having a document capable of being operatively coupled to a printing device, a method of printing the document on the printing device comprising the steps of:

15 storing a print schedule with an indication that the document should be printed at a user requested time;

15 automatically requesting, without user intervention, the document based on the print schedule;

20 transmitting the document to the printing device; and

20 causing automatic printing, without user intervention, the document on the printing device.

25 In the final office action, the Examiner combines Griebenow and Austin as the basis of his rejection of the Group I claims. The Examiner points out that Griebenow automatically sends periodicals to a user's computer or a "predetermined location", and that the user's computer includes a printer, but admits that Griebenow "does not explicitly disclose that the document will also be automatically printed on the user's printing device".¹³ The Examiner relies on Figure 4A of Austin for this teaching, stating that the "method of delivery (e.g., print) and frequency of delivery (e.g., monthly)... is **chosen by the user** and

¹³ Final Office Action of January 16, 2004, page 3.

stored in the user profile (emphasis added).¹⁴ Appellants believe Examiner's reliance on Austin for this teaching is erroneous. Fig. 4A and the accompanying description in column 10, lines 13-32 of Austin shows that while the user can select whether the statement should be sent in a variety of formats, including a format conducive to being printed, there is absolutely no suggestion that the user can also choose the frequency of delivery of this document. The word "monthly" on the screen in Fig 4A, like all the other non-highlighted portions of the screen in Fig 4A, is not capable of being selected or edited by the user. Therefore, in direct opposition of the examiner's assertions, Austin's user cannot choose the frequency of delivery. Fig 4A, cited by the Examiner, actually *teaches away* from Examiner's position that the frequency of delivery can be "chosen by the user".

The Examiner goes on to suggest¹⁵ that a user in Griebenow is capable of selecting that printing is done at a "user requested time", as Appellants are claiming in the Group I claims, simply by requesting a document that happens to be delivered at the same time to everyone who requests it, such as monthly. With all due respect to the Examiner, this type of reasoning is illogical and circular. If a user gets a document at the same time everyone else does, the user does not get this document at a "user requested time", as Appellants are claiming. This type of logic is akin to suggesting April 15th is a "user requested time" that taxes are due, or that 9:00 PM on Wednesday nights is a "user requested time" to watch *The West Wing* on NBC – the user has absolutely nothing to do with requesting the time of these events.

Since neither Griebenow or Austin, taken alone or together, disclose, teach or suggest "storing a print schedule with an indication that the document should be printed at a user requested time", the Examiner has failed to establish a *prima facie* case of obviousness with respect to the Group I claims.

¹⁴ Ibid.

¹⁵ Final Office action, page 9.

Claims contained in Groups IV, VI, and VII also contain this limitation and are also deemed patentable based on the same rationale as discussed above with respect to the Group I claims, although additional independent bases of patentability will be discussed for each of these groups.

5

The above is but one example of the Examiner improperly using hindsight gleaned from the knowledge of Appellant's specification to form the basis of the rejections. The Examiner admits using hindsight, but cites *In re McLaughlin*¹⁶ as support for the proposition that some forms of hindsight are acceptable..

10 Appellants agree with the Examiner that hindsight limited to knowledge within the level of ordinary skill in the art at the time the invention was made is acceptable, but this is not what Appellants maintain the Examiner is doing. *In re McLaughlin* supports Appellants' view that hindsight that includes "knowledge gleaned only from Appellants' disclosure"¹⁷, which Appellants assert the Examiner is doing, is
15 improper. As the CCPA said in *In re Sponnoble*,¹⁸ "The court must be ever alert not to read obviousness into an invention on the basis of the applicant's own statements; that is, we must view the prior art without reading into that art appellant's teachings... The issue, then, is whether the teachings of the prior art would, in and of themselves and without the benefits of appellant'[s] disclosure,
20 make the invention as a whole, obvious." ¹⁹

8B-II: The Examiner failed to establish a *prima facie* case of obviousness that Logan discloses, teaches or suggests Appellants' Group II claims

25

Claim 34 is representative of the Group II claims. Claim 34 claims the following:

¹⁶ *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

¹⁷ *In re McLaughlin* at 1395.

¹⁸ *In re Sponnoble*, 160 USPQ 237 (CCPA 1969).

¹⁹ *In re Sponnoble* at 243.

34. A method, comprising the steps of:

electronically monitoring by a document server the usage of a printing device; and

5 subsidizing the purchase of a product, based on the electronically monitoring step.

The Examiner relies on Column 26, lines 53-59 of Logan in rejecting the Group II claims, which states the following:

10 Subscriber billing is based on the accumulated amount of programming actually played by the subscriber with credit being given for advertising actually presented to the subscriber. To accomplish this, a detailed billing history can be constructed from the usage log which indicates the programs heard, the duration of each, and the cost (or credit) attributable to that program segment. ²⁰

15 The quoted passage has absolutely nothing to do with monitoring a printing device. The Examiner admits that Logan monitors an audio device instead of a printing device²¹, but believes that Logan provides sufficient motivation to monitor a printer instead. Appellants agrees that Logan monitors an audio device, but disagrees that Logan provides any motivation to monitor a printer instead.

25 The Logan reference is quite large, spanning 50 columns of text. In fact, according to the "word count" feature of Microsoft Word, the Logan reference contains over 27,000 words. One would think that if the Examiner is correct in asserting that Logan truly did provide a motivation to monitor a printer instead of an audio device, the terms "printer" or "printing" would appear regularly throughout such a large document. But these terms appear exactly zero times in Logan. While Logan does mention that text documents can be downloaded, there is no suggestion that these files are printed at all; this dubious link cannot 30 legitimately form the basis of the Examiner's position that a printer could be monitored. Once again, Appellants respectfully assert that the Examiner is

²⁰ Logan, col. 26, lines 53-59.

improperly using hindsight gleaned only from Appellants' disclosure to form the basis of this rejection, in contradiction of *In re McLaughlin*.

5 Since Logan does not disclose, teach or suggest "electronically monitoring by a document server the usage of a printing device", the Examiner has failed to establish a *prima facie* case of obviousness with respect to the Group II claims.

10 Claims contained in Groups V, VI, VII, VIII, and IX also contain this limitation and are also deemed patentable based on the same rationale as discussed above with respect to the Group II claims, although additional independent bases of patentability will be discussed for each of these groups.

15 ***8B-III: The Examiner failed to establish a prima facie case of obviousness that Griebenow and Austin, taken singly or together, disclose, teach or suggest Appellants' Group III claim***

20 Claim 77 is the sole Group III claim. Claim 77 claims the following:

25 77. In a document delivery system having a document capable of being operatively coupled to a printing device, a method of printing the document on the printing device comprising the steps of:

30 30
storing a print schedule;
automatically requesting, without user intervention, the document based on the print schedule;

transmitting the document to the printing device;

²¹ Final Office Action, page 6.

causing automatic printing, without user intervention, the document on the printing device;

storing a user profile; and

responsive to causing printing of the document on the printing device, updating the user profile with an indication that the document printed successfully.

10 The Examiner again relies on Griebenow in view of Austin to form
the basis of this rejection. Specifically, the Examiner cites Column 7, lines 10-55
of Griebenow as providing support for his view that Griebenow “discloses
updating the user profile to reflect the delivery (printing) of the document (using a
return receipt)”²²

15

The cited passage of Griebenow states the following:

If the consumer has updated the consumer profile, billing and demographics engine 52 may also use portions of the consumer profile to access a demographics database and update demographic information contained in the consumer profile. For example, billing and demographics engine 52 may calculate an estimate of the consumer's income based upon the zip code in which the consumer resides. Thus, the publisher could estimate the consumer's income without having to ask the consumer questions about his income. The method then continues in step 100.

25 If the consumer had not ordered a publication from the publisher before when the check was made in step 94, then step 98 is executed. In step 98, a consumer profile is generated based upon information provided by the consumer. The consumer profile may include both demographic items reflecting demographic data about the consumer and personal items reflecting more personal data about the consumer. Demographic data may include the consumer's age, sex, marital status, number of children, age of children, occupation, 30 city of residence, state of residence, zip code, etc. Personal items may include the consumer's vacation preferences, food preferences, automobile preferences, hobbies, leisure activities, etc. In the case where a consumer orders an electronic publication dealing with a specific subject such as the consumer's hobby, the consumer profile may include more detailed information. Thus, even if the consumer has ordered an electronic publication before, the consumer may need to provide additional information in step 96 as to

22 Final Office Action, page 4.

additional consumer profile items. For example, if the electronic publication is an electronic magazine about bicycling, the consumer may be asked to provide the number of bicycles owned, the maker of the bicycles, the maker of various parts on the bicycles, the bicycle accessories owned by the consumer, the most common uses that the consumer makes of a bicycle, whether the consumer takes bicycling vacations, 5 etc. The publisher of the electronic publication may then use this consumer profile data to create a customized electronic publication for the consumer, including either customized content, customized advertising, or both.

Continuing in step 98, after obtaining the consumer profile information, billing information is obtained and 10 the consumer is billed using billing and demographics engine 52 as was described for step 96. In addition, the demographics database is accessed and consumer profile updated as was done in step 96.²³

Lots of information here, but none of it appearing to have anything to do with "updating a user profile with an indication that the document printed 15 successfully", as Appellants are claiming in the Group III claims. Griebenow does disclose elsewhere in their specification that a "return receipt" may be requested when the electronic document has been delivered, and that this receipt is "stored in storage 60"²⁴, but fails to disclose, teach, or suggest that this "return receipt" can indicate that "the document printed successfully", or that a 20 "user profile" is updated with this information, as Appellants are claiming. Since Griebenow forms part of the rejection of the Group III claims and fails to disclose, teach, or suggest what the Examiner asserts it does, the Examiner failed to establish a *prima facie* case of obviousness for the Group III claim.

25 The Examiner then turns to the Austin reference, stating that "Austin also discloses that the system will verify successful delivery of the document to the user's printer (col 13, lines 13-17) and that this information is used to update the customer file (col 15, lines 13-23).

30 The cited passages of the Austin reference state the following:

²³ Griebenow, Col 7, lines 10-55.

²⁴ Griebenow, Col. 8, lines 13-17.

Additionally, verification that the correct information was delivered to the requesting user may also be performed (Block 180). Verification operations may include verifying that all pages of a document are delivered, verifying that the information was delivered in the correct medium, and the like.

5 Mail-piece integrity across all modes of communication, according to aspects of the present invention, includes, but is not limited to: who the mail-piece is to be delivered to; how the mail-piece is to be generated and delivered to the customer; what additional information, including format, is to be transmitted with mail-piece. A file for each customer may be generated and maintained utilizing existing information about the customer. When a mail-piece is delivered to a customer, the contents delivered to the
10 customer are compared with the appropriate file.²⁵

While quite sketchy on the details as to how this is done, Austin does appear to disclose verification of successful delivery of the document to the user, and verification that the correct medium (such as a document to be printed) was used. But a closer reading of Austin shows that Austin does not go so far as to disclose, teach, or suggest a way of knowing that the document was successfully delivered to the printer and actually printed, and therefore does not disclose, teach, or suggest a way of determining that the "document printed successfully", as Appellants are claiming. Moreover, while Austin's customer file could be construed to be a "user profile", a closer reading of the cited portion of the Austin reference does not indicate that Austin discloses, teaches, or suggests the ability of "updating the user profile with an indication that the document printed successfully", as Appellants are claiming.

25 For each of the reasons stated above, the Examiner failed to establish a *prima facie* case for the Group III claim.

Claims contained in Groups IV, VI, VII, and VIII also contain this limitation and are also deemed patentable based on the same rationale as discussed
30 above with respect to the Group III claims, although additional independent bases of patentability will be discussed for each of these groups.

5

8B-IV: The Examiner failed to establish a *prima facie* case of obviousness that Griebelnow and Austin, taken singly or together, disclose, teach or suggest Appellants' Group IV claims

Group IV claims contain the limitations of the Group I and Group III claims, each of which have already been shown above to be independently patentable.

10 The combination of the limitations of these Groups provides an additional basis for patentability. Therefore, the Examiner has failed to establish a *prima facie* case of obviousness for the Group IV claims.

15 ***8B-V: The Examiner failed to establish a *prima facie* case of obviousness that Griebelnow, Austin, and Logan, taken singly or together, disclose, teach or suggest Appellants' Group V claims***

20 Claim 81 is representative of the Group V claims. Claim 81 claims the following:

25

81. A method, comprising the steps of:

electronically monitoring by a document server the usage of a printing device; and

subsidizing the purchase of a product that is depleted upon the usage of the printing device, based on the electronically monitoring step.

30 Group V claims contain limitations of the Group II claims, shown above to be patentable. Therefore, the Group V claims are also deemed patentable for the reasons discussed above with respect to the Group II claims. In addition, the

²⁵ Austin, Col 13, lines 13-17; Col 15, lines 13-23.

Group V claims contain an additional limitation that the product subsidized is “depleted upon the usage of the printing device”, as Appellants are claiming. This limitation provides an independent basis for patentability over the art of record, as will now be discussed.

5

The Examiner combines Griebenow, Austin, and Logan together to form the basis for rejecting claim 81, as follows: “Griebenow, Austin, and Logan disclose a method for automatically printing and subsidizing a document as in claims 4, 16, and 34 above. All three references further disclose sending various 10 types of advertising and promotional products, such as a free or discounted print consumable, printable media (e.g., coupon) or product to the user”. ²⁶

As support for this view, the Examiner cites large portions of Griebenow (Col 10 lines 58- column 11, line 22), Austin (col 10, lines 34-44 and 59-67) and 15 Logan (col 24 lines 1-14), as follows:

The invention also provides an additional benefit to advertisers. Reading application 20 allows an advertiser to design an advertisement such that the consumer can input information indicating either that he desires to obtain more information about a product or service or that he desires to order a product or 20 service. A request for more information causes additional information to be output to the consumer from the reading application 20. If the consumer desires to order a product or service, reading application 20 can automatically dial up a computerized order processing service for the product or service or send an electronic mail message to the advertiser such that the electronic mail message orders the product or service automatically. This feature of the invention provides additional benefits to the advertiser and makes 25 purchasing products and services easier for a consumer.

The invention may also be used to increase sales of other publications sold by the publisher. For example, fulfillment engine 22 may give a consumer the option to purchase back issues of the electronic publication. Also, based upon the consumer profile input by the consumer, fulfillment engine 22 may offer the 30 consumer additional electronic publications based upon one or more profile data items in the consumer profile.

The distribution system of the invention could also be used to distribute updated versions of reading

application 20 to consumers. To accomplish this feature, fulfillment engine 22 may deliver the updated version of reading application 20 to the consumer's electronic mail address on the Internet 16. The consumer would then download the new version of the reading application 20 to the consumer's computer 12 and replace the old version of reading application 20.²⁷

5

There are advertising buttons 64a, 64b, 64c, 64d across the top portion of the statement. The illustrated advertising buttons 64a, 64b, 64c, 64d are hypertext links to information contained within the same source that transmitted the e-mail to the customer, or to other Web sites. The present invention allows 10 for businesses to present selected advertising based upon customer profiles. For example, a 75 year old customer with brokerage holdings in excess of \$10 million may be presented with different advertisement options than a 40 year old customer with brokerage holdings valued at less than \$10 thousand.

15 The present invention allows businesses to track which customers look at what information. Customer information can then be updated to more accurately reflect a particular customer's interests. By using historical tracking information, the present invention allows businesses to continually refine what types of advertisements and information appeal to each customer, thereby increasing marketing effectiveness and efficiency.²⁸

20

Targeted Advertising

25 In order to identify and insert advertising program segments into the Schedule Table 307, the preferred embodiment of the invention utilizes additional information which describes each advertisement to be placed before subscribers. This information is placed in an Advertisement record having the structure defined earlier and held in the Advertisements Table 311. The ProgramID field of the Advertisement record identifies a Program.sub.-- Segment record (described earlier) which describes the content of the advertisement itself. The remainder of the Advertisement record contains additional information used to control the manner in which the identified advertising program segment is selected for insertion into the programming supplied to subscribers.²⁹

30

Again, there is a lot of information in the above cited passages, but none of this information has anything remotely to do with disclosing, teaching, or

²⁶ Final Office Action, pages 7-8.

²⁷ Griebenow, Col 10, line 58 – Col 11, line 22.

²⁸ Austin, Col 10, lines 34-44 and 59-67.

²⁹ Logan, Col 24, lines 1-14.

suggesting "subsidizing the purchase of a product that is depleted upon the usage of the printing device" , as Appellants are claiming. It seems quite clear to Appellants that the Examiner has once again improperly relied on hindsight gleaned solely from Applicants teachings to form the true basis for this rejection,
5 and has therefore failed to establish a *prima facie* case of obviousness for the Group V claims.

10 ***8B-VI: The Examiner failed to establish a prima facie case of obviousness that Griebenow and Austin and Logan, taken singly or together, disclose, teach or suggest Appellants' Group VI claim***

15 The Group VI claim contains the limitations of the Group I, Group II and Group III claims, each of which have already been shown above to be independently patentable. The combination of the limitations of these Groups provides an additional basis for patentability. Therefore, the Examiner has failed to establish a *prima facie* case of obviousness for the group VI claim.

20 ***8B-VII: The Examiner failed to establish a prima facie case of obviousness that Griebenow and Austin and Logan, taken singly or together, disclose, teach or suggest Appellants' Group VII claims***

25 Group VII claims contain the limitations of the Group I, Group III, and Group V claims, each of which have already been shown above to be independently patentable. The combination of the limitations of these Groups provides an additional basis for patentability. Therefore, the Examiner has failed
30 to establish a *prima facie* case of obviousness for the Group VII claims.

5 ***8B-VIII: The Examiner failed to establish a *prima facie* case of obviousness that Logan discloses, teaches or suggests Appellants' Group VIII claims***

10 Group VIII claims contain the limitations of the Group II and Group III claims, each of which have already been shown above to be independently patentable. The combination of the limitations of these Groups provides an additional basis for patentability. Therefore, the Examiner has failed to establish a *prima facie* case of obviousness for the Group VIII claims.

15 ***8B-IX: The Examiner failed to establish a *prima facie* case of obviousness that Logan discloses, teaches or suggests Appellants' Group IX claim***

20 Claim 37 is the sole Group IX claim. Claim 37 depends on claim 34. Claim 37, rewritten below for simplicity purposes to include the limitations of claim 34, claims the following:

25 A method, comprising the steps of:
 electronically monitoring by a document server the usage of a printing device; and
 subsidizing the purchase of a product, based on the electronically monitoring step;
 updating a user profile to indicate the amount of ink that was used when a document was printed.

30 Group IX claims contain limitations of the Group II claims, shown above to be patentable. Therefore, the Group IX claims are also deemed patentable for

the reasons discussed above with respect to the Group II claims. In addition, the Group IX claims contain an additional limitation that the user profile is updated "to indicate the amount of ink that was used when a document was printed". This limitation provides an independent basis for patentability over the art of record,
5 as will now be discussed.

In forming the rejection for claim 37, the Examiner again relies on column 26, lines 53-59 of Logan, which states the following:

10 Subscriber billing is based on the accumulated amount of programming actually played by the subscriber with credit being given for advertising actually presented to the subscriber. To accomplish this, a detailed billing history can be constructed from the usage log which indicates the programs heard, the duration of each, and the cost (or credit) attributable to that program segment. ³⁰

15 Once again, the quoted passage has absolutely nothing to do with updating a user profile "to indicate the amount of ink that was used when a document was printed", as Appellants are claiming. The Examiner relies on this language in stating that "Logan discloses tracking and storing (in a usage log) the costs to deliver an audio file".³¹ This is incorrect, as it is clear from the above
20 cited passage that Logan actually tracks whatever the content provider is charging for the file, not the actual (and clearly negligible) costs to electronically deliver it. Contrast this with tracking the amount of ink used to print a document, as Appellants are claiming, for which a very real cost is indeed incurred.

25 In reliance on this erroneous reading of Logan, the Examiner goes on to state that "it would have been obvious to one of ordinary skill in the art at the time the invention was made that the same steps could be used to determine the cost of delivering other electronic files to include the costs of printing an electronic document, such as the amount of ink and/or paper used." ³²

30

³⁰ Logan, col. 26, lines 53-59.

³¹ Final Office Action, page 6.

Once again, out of the 27,000 words in the Logan reference, one would think that if this reference truly discloses, teaches, or suggests “updating a user profile to indicate the amount of ink that was used when a document was printed”, as Appellants are claiming, the word “ink” would appear multiple times throughout the document. But this is not the case – the word “ink” makes exactly zero appearances in Logan. Appellants believe this is an extremely clear example of Examiner’s improper use of hindsight gleaned only from Appellants’ disclosure to form the basis of this rejection, in contradiction of *In re McLaughlin*.

Since Logan does not disclose, teach or suggest “updating a user profile to indicate the amount of ink that was used when a document was printed” the Examiner has failed to establish a *prima facie* case of obviousness with respect to the Group XI claim.

15 8B-X: The Examiner failed to establish a *prima facie* case of obviousness that Logan discloses, teaches or suggests Appellants’ Group X claim

Claim 38 is the sole Group X claim. Claim 38 depends on claim 37, discussed above with respect to Group IX, but contains the additional limitation of “updating the user profile to indicate the amount of each of a plurality of different colored ink that was used when a document was printed.”. As stated above, Logan clearly does not disclose, teach, or suggest updating a user profile with the amount of ink used during the printing operation, let alone “each of a plurality of different colored ink”, as is claimed in claim 38. Therefore, the Examiner has failed to establish a *prima facie* case of obviousness with respect to the Group X claim.

³² *Ibid.*

9. Conclusion

5 The Examiner erred by failing to establish a *prima facie* case of obviousness in rejecting claims 1-22, 33-48, and 77-85 under 35 USC § 103(a) over Griebenow, Austin, and/or Logan. Appellants respectfully request reversal of these rejections from the Board of Patent Appeals and Interferences, along with timely issuance of a notice of allowance indicating that claims 1-22, 33-48, and 77-85 are allowed.

10

Respectfully Submitted,

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APPENDIX

5. The method of claim 4, wherein the subsidizing a product step further comprises the step of:

sending a print consumable to the user.

5

6. The method of claim 4, wherein the subsidizing a product step further comprises the step of:

sending a coupon for a free print consumable to the user.

10

7. The method of claim 4, wherein the subsidizing a product step further comprises the step of:

sending a coupon for a reduced price print consumable to the user.

15

8. The method of claim 4, wherein the subsidizing a product step further comprises the step of:

sending printable media to the user.

20

9. The method of claim 4, wherein the subsidizing a product step further comprises the step of:

sending a coupon for printable media to the user.

25

10. The method of claim 4, wherein the subsidizing a product step further comprises the step of:

sending a second printing device to the user.

30

11. The method of claim 4, wherein the subsidizing a product step further comprises the step of:

sending a coupon for a second printing device to the user.

5

12. The method of claim 2, further comprising the steps of:

including advertising content into the document.

10 13. The method of claim 12, wherein the step of including advertising content further comprises the step of:

personalizing the advertising content based on the user profile.

15 14. The method of claim 2, wherein the step of transmitting the document further comprises the step of personalizing the content of the document based on the user profile.

15. The method of claim 13, further comprising the step of:

20

responsive to the causing printing step, updating the user profile with an indication that the document printed successfully.

16. The method of claims 15, further comprising the step of:

25

responsive to the updating step, subsidizing a product for a user.

17. The method of claim 16, wherein the subsidizing a product step further comprises the step of:

30

sending a print consumable to the user.

18. The method of claim 16, wherein the subsidizing a product step further comprises the step of:

5 sending a coupon for a free print consumable to the user.

19. The method of claim 16, wherein the subsidizing a product step further comprises the step of:

10 sending a coupon for a reduced price print consumable to the user.

20. The method of claim 16, wherein the subsidizing a product step further comprises the step of:

15 sending printable media to the user.

21. The method of claim 16, wherein the subsidizing a product step further comprises the step of:

20 sending a coupon for printable media to the user.

22. The method of claim 16, wherein the subsidizing a product step further comprises the step of:

25 sending a second printing device to the user.

33. The method of claim 3, further comprising the steps of:

the document server inserting personalized advertising into the document
30 from an advertising provider based on the user profile; and

retrieving the document from the document server coupled to the printing device via a network.

34. A method, comprising the steps of:

5

electronically monitoring by a document server the usage of a printing device; and

10 subsidizing the purchase of a product, based on the electronically monitoring step.

35. The method of claim 34, wherein the electronically monitoring step further comprises the step of:

15 updating a user profile to indicate that a document has been printed for a user.

36. The method of claim 35, wherein the updating step indicates that advertising in the document has been printed.

20

37. The method of claim 34, wherein the electronically monitoring step further comprises the step of:

25 updating a user profile to indicate the amount of ink that was used when a document was printed.

38. The method of claim 37, wherein the updating step further comprises the steps of:

30

updating the user profile to indicate the amount of each of a plurality of different colored ink that was used when a document was printed.

39. The method of claim 34, wherein the product in the subsidizing step is a print consumable.

5 40. The method of claim 34, wherein the product in the subsidizing step is printable media.

41. The method of claim 34, wherein the product in the subsidizing step is a second printing device.

10

42. The method of claim 34, wherein the product in the subsidizing step is a subscription.

15

43. The method of claim 34, wherein said subsidizing step is funded by advertising revenue.

44. The method of claim 34, wherein said subsidizing step is funded by distribution revenue.

20

45. The method of claim 43, wherein said subsidizing step is funded by distribution revenue.

46. The method of claim 35, further comprising the step of providing information about the document that was printed for the user to an advertising provider.

25

47. The method of claim 35, further comprising the step of providing information about the document that was printed for the user to a content provider.

30

48. The method of claim 46, further comprising the step of providing information about the document that was printed for the user to a content provider.

77. In a document delivery system having a document capable of being operatively coupled to a printing device, a method of printing the document on the printing device comprising the steps of:

5 storing a print schedule;

 automatically requesting, without user intervention, the document based on the print schedule;

10 transmitting the document to the printing device;

 causing automatic printing, without user intervention, the document on the printing device;

15 storing a user profile; and

 responsive to causing printing of the document on the printing device, updating the user profile with an indication that the document printed successfully.

20 78. The document delivery system of claim 77, wherein the print schedule further comprises an indication that the document should be printed at a user requested time.

25 79. The document delivery system of claim 78, wherein the user requested time is a specific day of the week or month.

80. The document delivery system of claim 78, wherein the user requested time is the lapse of a user specified time period.

30 81. A method, comprising the steps of:

electronically monitoring by a document server the usage of a printing device; and

5 subsidizing the purchase of a product that is depleted upon the usage of the printing device, based on the electronically monitoring step.

82. The method of claim 81, wherein the product in the subsidizing step is mailed to the user.

10 83. The method of claim 81, wherein a coupon for the product in the subsidizing step is sent to the user.

15 84. The method of claim 81, wherein the product in the subsidizing step is a print consumable.

85. The method of claim 81, wherein the product in the subsidizing step is printable media.